Remarks: Examination Report

1. Claims 44-136 were rejected under 35 U.S.C. 102(e) as being anticipated by Shattil (US 6,331,837).

2. ***Relied-Upon Reference Shattil (US 6,331,837) Should be Disqualified as Prior Art***

In particular, the basis for rejection citing 35 U.S.C. 102(e) states that a person shall be entitled to a patent unless the invention was described in a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent.

3. The cited reference US 6,331,837 was derived from the inventor of this application

The cited reference US 6,331,837 was derived from the inventor of this application and is thus not the invention "by another."

4. ***Relied-Upon Reference Shattil (US 6,331,837) Should be Disqualified as Prior Art under 35 U.S.C. 103***

The burden of establishing that subject matter is disqualified as prior art is placed on applicant once the examiner has established a *prima facie* case of obviousness based on the subject matter.

5. **MPEP 706.02(l)(2) Establishing Common Ownership**

In order to be disqualified as prior art under 35 U.S.C. 103(c), the subject matter which would other-wise be prior art to the claimed invention and the claimed invention must be commonly owned at the time the claimed invention was made. See MPEP § 706.02(l) for 35 U.S.C. 102(f)/103 or 35 U.S.C. 102(g)/103 prior art disqualified under 35 U.S.C. 103(c). See MPEP § 706.02(l)(1) for 35 U.S.C. 102(e)/103 prior art disqualified under 35 U.S.C. 103(c).

6. MPEP 706.02(l)(2) Establishing Common Ownership

Section II

The following statement is sufficient evidence to establish common ownership of, or an obligation for assignment to, the same person(s) or organizations(s):

Applications and references (whether patents, patent applications, patent application publications, etc.) will be considered by the examiner to be owned by, or subject to an obligation of assignment to the same person, at the time the invention was made, if the applicant(s) or an attorney or agent of record makes a statement to the effect that the application and the reference were, at the time the invention was made, owned by, or subject to an obligation of assignment to, the same person.

See "Guidelines Setting Forth a Modified Policy Concerning the Evidence of Common Ownership, or an Obligation of Assignment to the Same Person, as Required by 35 U.S.C. 103(c)," 1241 O.G. 96 (December 26, 2000). The applicant(s) or the representative(s) of record have the best knowledge of the ownership of their application(s) and reference(s), and their statement of such is sufficient evidence because of their paramount obligation of candor and good faith to the USPTO.

The statement concerning common ownership should be clear and conspicuous (e.g., on a separate piece of paper or in a separately labeled section) in order to ensure that the examiner quickly notices the statement.

For example, an attorney or agent of record receives an Office action for Application X in which all the claims are rejected under **35 U.S.C. 103(a)** using Patent A in view of Patent B wherein Patent A is only available as prior art under 35 U.S.C. 102(e), (f), and/or (g). In her response to the Office action, the attorney or agent of record for Application X states, in a clear and conspicuous manner, that:

> "Application X and Patent A were, at the time the invention of Application X was made, owned by Company Z."

This statement alone is sufficient evidence to disqualify Patent A from being used in a rejection under **35 U.S.C. 103(a)** against the claims of Application X.

7. **Application 09/381,588** ***and Patent US 6,331,837 are owned by a common entity***

Application 09/381,588 and Patent US 6,331,837 were, at the time the invention of Application 09/381,588 was made, subject to an obligation of assignment to and owned by GenghisComm LLC.

Very respectfully,

Steve Shattil

4980 Meredith Way #201
Boulder, CO 80303
720 564-0691